

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8

In re application of	)	Examiner: M. Marks
CARY L. QUEEN ET AL.	)	Art Unit: 185
Serial No.: 07/310,252	)	PETITION FOR WITHDRAWAL
Filed: February 13, 1989	)	OF HOLDING OF ABANDONMENT
For: DESIGNING IMPROVED	)	
HUMANIZED IMMUNOGLOBULINS	)	
		San Francisco, CA 94105

Commissioner of Patents and Trademarks  
Washington, D. C. 20231

Sir:

In response to the Notice of Abandonment, mailed June 1, 1990 in the above referenced case, which notice was sent for failure to respond to an Office letter mailed Nov. 7, 1989, Applicants hereby petition for a withdrawal of the holding of abandonment, on the ground of non-receipt of the office action. Applicants respectfully request that the Notice of Abandonment be withdrawn, and that the November 7, 1989 office action be sent again, with additional time for response.

This petition is filed pursuant to MPEP § 711.03(c), and is supported by verified statements of Debra B. Hudson and Michele A. Simone, docket clerks for Applicants' attorneys, at Townsend and Townsend, San Francisco, CA. This petition is further supported by verified documentary evidence showing non-receipt of the office action in question, and further showing that another office action in a related case, mailed the same day, was received promptly and was responded to in a timely manner.

The facts surrounding non-receipt of the Office Action are outlined below:

1. U.S. Patent Application Serial No. 07/290,975 (the '975 application), was filed on December 28, 1988.
2. The above-referenced U.S. Patent Application Serial No. 07/310,252 (the '252 application), a continuation-in-part of the '975 application, was filed on February 13, 1989. The '975 application remains pending.

LAW OFFICES OF TOWNSEND & TOWNSEND

3. An office action requiring restriction or election in the '975 case, mailed November 7, 1989, was received by Applicants' attorneys on November 10, 1989. See Exhibit A, which is a true and complete copy of the November 7, 1989 office action in the '975 case, showing a date of receipt of November 10, 1989. See also Exhibit B, which is a true and complete copy of a print-out of Applicants' attorneys' docket sheet for the '975 case, printed out on June 8, 1990, and having an entry under the heading "P.O. Action" of "110789", showing receipt of an office action dated November 7, 1989.
4. The PTO reports that on the same day that the office action in the '975 case was mailed (November 7, 1989), an office action requiring restriction or election was also mailed in the related '252 case. See Exhibit C, which is a true and complete copy of the Notice of Abandonment in the '252 case, showing abandonment for failure to respond to an office action dated November 7, 1989.
5. No office action was received by Applicants or their attorneys, at that time, or at any time, in the '252 case. See Exhibit D, which is a true and complete copy of a print-out of Applicants' attorneys' docket sheet for the '252 case, printed out on June 8, 1990, showing no entries under the heading "P.O Action".
6. A timely response to the office action in the '975 case was mailed to the Patent Office on March 7, 1990. See Exhibit E, which is a true and complete copy of Applicants' response to the November 7, 1989 office action in the '975 case. The response was received by the Patent Office on March 12, 1990. See Exhibit F, which is a true and complete copy of the date-stamped postcard showing receipt of the response in the PTO on March 12, 1990.
7. On or about May 17, 1990, Applicants' attorneys received a telephone call from Examiner Marks, acknowledging receipt of the response in the '975 case, and stating that no response had been received in the '252 case. This was the first

07/310,252

- 2 -

11823-9

indication to either Applicants or Applicants' attorneys that there had been an office action in the '252 case.

8. On June 4, 1990, Applicants' attorneys received a Notice of Abandonment for failure to respond to the November 7, 1989 office action in the '252 case. The Notice of Abandonment was mailed on June 1, 1990. See Exhibit C, showing a date of receipt of June 4, 1990.
9. Applicants diligently filed this petition upon receipt of the Notice of Abandonment.

As is apparent from these facts, there were two office actions in the related '975 and '252 cases, mailed on the same day, each requiring an election or restriction. Applicants' attorneys received only one of these actions (as evidenced by the entries on the computerized docket sheets, Exhibits B and D). Applicants timely responded to the one office action that was received. Had Applicants received or known of the existence of the second office action, it too would have been responded to in a timely way.

Applicants' attorneys have reviewed their docketing and mail handling procedures to assure that the office action had in fact never been received. The following facts reflect that review. These facts are further verified in the accompanying Verified Statements of Debra B. Hudson and Michele A. Simone, docket clerks for Applicants' attorneys at Townsend and Townsend, San Francisco, CA.

1. The following procedures and controls are utilized by Applicants' attorneys with respect to correspondence received from the Patent Office (see the accompanying Verified Statement of Debra B. Hudson):
  - i. When communications from the PTO are received in the mailroom, they are immediately date-stamped, and are then sent to the appropriate docketing department (U.S. or foreign). Mail is delivered from the mailroom directly to the docketing department early each morning.  
*001 TWD*

*L7:1 pg 92 2006*

- ii. On receiving the PTO communication in the docketing department, a docket clerk will enter the serial number of the application into the computer, to call up the appropriate docket file.
  - iii. The docket clerk will put the working attorney's initials and the firm file number in red on the upper right hand corner of the document.
  - iv. The docket clerk will also place a red stamp reading "Response Due" on the front of the office action, and write in large red characters the date the response is due.
  - v. The docket clerk will then enter the PTO action and date, and the response due date into the computer.
  - vi. The PTO communication is then immediately forwarded to the working attorney.
  - vii. Entries are also made in the computer docket when communications are sent from the working attorney to the PTO.
2. The above procedures and controls were followed in the situation at hand in the following way (see the accompanying Verified Statements of Debra B. Hudson and Michele A. Simone):
  - i. The docketing department received an office action in the case of Application Serial No. 07/290,975, which had been mailed on November 7, 1989, and had been date-stamped in the mailroom as received on November 10, 1989.
  - ii. Upon receipt of that document, the docket clerk (Debra B. Hudson) stamped and wrote the "Response Due" date (December 7, 1989) on the front of the document in red ink, wrote the working attorney's initial and the firm file number (WMS 11823-8) in the top right hand corner of the front page, and entered the relevant information into the computer docket. She signed her initials on the front page after the Response Due date (DBH).

iii. No office action was entered into the computer docket on that date, or any other date, for the case of Application Serial No. 07/310,252.

iv. The docketing department received and entered in the computer docket a Notice of Abandonment for Application Serial No. 07/310,252, for failure to respond to an office action allegedly mailed November 7, 1989. The document was date-stamped as received on June 4, 1990. Michele A. Simone received the document, and wrote the firm file number and working attorney's initials in red in the top right hand corner of the document.

v. Ms. Simone immediately checked to see if there was any record of receipt of the November 7, 1989 office action. There was none. She then forwarded the Notice of Abandonment to the working attorney.

The above facts show that (1) Applicants' attorneys' procedures and controls are adequate to handle communications received from the PTO, and that (2) Applicants' attorneys never received the November 7, 1989 office action in the above-identified application.

Applicants therefore request that the holding of abandonment be withdrawn pursuant to MPEP § 711.03(c), and that the November 7, 1989 office action be sent again, with additional time for response. As this petition has been filed promptly after the Notice of Abandonment, no terminal disclaimer is required.

Respectfully submitted,

TOWNSEND and TOWNSEND

By William M. Smith  
William M. Smith  
Reg. No. 30,223

Date: 6-20-90

Telephone: (415) 326-2400

One Market Plaza  
Steuart Street Tower  
San Francisco, CA. 94105

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark OfficeAddress: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/290,975	12/26/88	QUEEN	C 118236

*RECEIVED*

□ WILLIAM M. SMITH  
TOWNSEND AND TOWNSEND  
STUART STREET TOWER, ONE MARKET PLAZA  
SAN FRANCISCO, CA 94105

EXAMINER	
MARKS, M	
ART UNIT	PAPER NUMBER
185	2

*Response Due December 7, 1988*

11/07/88

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined       Responsive to communication filed on \_\_\_\_\_       This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |  |   |
|--|---|
| <input type="checkbox"/> 1. Notice of References Cited by Examiner, PTO-892.       | <input type="checkbox"/> 2. Notice re Patent Drawing, PTO-948.                  |
| <input type="checkbox"/> 3. Notice of Art Cited by Applicant, PTO-1449             | <input type="checkbox"/> 4. Notice of Informal Patent Application, Form PTO-152 |
| <input type="checkbox"/> 5. Information on How to Effect Drawing Changes, PTO-1474 | <input type="checkbox"/> 6. _____   |

**Part II SUMMARY OF ACTION**

1.  Claims 1-26 are pending in the application.
2.  Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
3.  Claims \_\_\_\_\_ have been cancelled.
4.  Claims \_\_\_\_\_ are allowed.
5.  Claims \_\_\_\_\_ are rejected.
6.  Claims 1-26 are subject to restriction or election requirement.
7.  This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8.  Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9.  The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are  acceptable;  not acceptable (see explanation).
10.  The  proposed drawing correction and/or the  proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has/have been  approved by the examiner.  disapproved by the examiner (see explanation).
11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved.  disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14.  Other \_\_\_\_\_

Serial No. 07/290975  
Art Unit 185

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-20 and 22-24, drawn to a composition comprising a human-like immunoglobulin specific for p55 Tac (i.e., IL-2), classified in Class 424 subclass 85.

II. Claim 21, drawn to a method of treating T-cell mediated disorders in humans, classified in Class 424, subclass 85.

III. Claims 25-26, drawn to polynucleotides and cells transformed with same, classified in Class 536, subclass 27 and class 435 subclass 240.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group III and Group I are related as mutually exclusive species in intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful other than to make the final product (MPEP section 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP section 806.04(h)).

In the instant case, the intermediate product is deemed to be useful as a diagnostic probe and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be

Serial No. 07/290975  
Art Unit 185

used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as non-recombinant immunoglobulins specific for Tac. Also the product as claimed can be used in a materially different process of using that product such as in in vitro diagnostic to identify Tac presenting cell populations.

Inventions Group I and Group III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as chemical synthesis or by production in humans.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, and because the searches for the individual Groups are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Serial No. 07/290975  
Art Unit 105

A telephone call was made to William Smith on October 19, 1989, to request an oral election to the above restriction, but did not result in an election being made.

Applicant is reminded that upon the cancellation of a non-elected invention, the inventorship must be changed in compliance with 37 CFR 1.48(b) if one or more of the originally named inventors is no longer an inventor of at least one invention remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.17(h), and by the fee required under 37 CFR 1.17(h).

Any inquiry concerning this communication should be addressed to Michelle Marks, Ph.D. whose telephone number is 703-285-0664.

*MJM*

THOMAS G. WISEMAN  
SUPERVISORY PATENT EXAMINER  
ART UNIT 105

Express Mail No. PATENT APPLICATION  
B22186637W FILING ACKNOWLEDGEMENT

File No.: 11823-9

Attorney: WMS

Queen & Harold Edwin Selick  
DOVED HUMANIZED IMMUNOGLOBULINS

Power of Attorney  
Small Entity Decl.

29

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10

**B22186637W**

**POST OFFICE  
TO ADDRESSEE**



EX-PRESS MAIL  
SERV-ICE

For Customer Use		For Postal Use	
Origin	Date	Postage	AMOUNT
Post Office Code	10/13/84	\$	1.25
Phone Number	202-223-4474	Postage	
Hours of Operation	10 AM - 4 PM	Amount	
Holdings Check	Weight	Received	
Accepted for next day delivery	Time	Received	
<input type="checkbox"/> Accepted for next day delivery	10 AM	Received	
Acceptable for compensation after deposit deadline for non-expedited delivery, or delivery by second day.			
International Or Demand Money Order			
Express Mail Corporate Account No.:	Initial Signature		
FROM:	Postage Stamp L.P. 10/13/84		

**CUSTOMER RECEIPT**

**SEE REVERSE FOR SERVICE GUARANTEE,  
INSURANCE COVERAGE AND CLAIMS**

**WAIVER OF  
SIGNATURE**

I wish delivery to be made without a stamping the signature of the  
customer or the addressee's agent. I authorize the delivery to be  
made by any of the delivery employees with constitutes valid proof of delivery.

SIGNED: \_\_\_\_\_

Telephone Number: \_\_\_\_\_

**TO:**

COMMISSIONER OF PATENTS  
AND TRADEMARKS  
WASHINGTON DC 20231-4444

Express Mail No. PATENT APPLICATION  
B22186637W FILING ACKNOWLEDGEMENT

File No.: 11823-9  
Attorney: WMS

Inventor(s): Cary L. Queen & Harold Edwin Selick  
DESIGNING IMPROVED HUMANIZED IMMUNOGLOBULINS

Title: DESIGNING IMPROVED HUMANIZED IMMUNOGLOBULINS  
Power of Attorney  
Small Entity Decl.

Declaration Power of Attorney  
Combined Declaration & Power of Attorney  
Assignment Small Entity Decl.

XX Assignment Small Entity Decl.  
 XX Pages of Spec. 29  
 XX No. Pages of Claims: 5  
 XX No. Pages of Drawgs: 10  
 XX No. Sheets Drawgs: 75

**11/310252**

please stamp the date of receipt of the enclosed  
documents and return this card to addressee.

## FILING RECEIPT



UNITED STA. DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOTAL	IND CL
07/310,252	02/13/89	185	\$ 279.00	118239		100	3

WILLIAM M. SMITH  
TOWNSEND AND TOWNSEND  
STEUART STREET TOWER  
ONE MARKET PLAZA  
SAN FRANCISCO, CA 94105

Receipt is acknowledged of the patent application identified herein. It will be considered in its order and you will be notified as to the examination thereof. Be sure to give the U.S. SERIAL NUMBER, DATE OF FILING, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this transmittal.

Applicant(s) CARY L. QUEEN, PALO ALTO, CA; HAROLD E. SELICK, BELMONT, CA.

CONTINUING DATA-THIS APPLN IS A CIP OF 07/290,975 12/28/88

FOREIGN FILING LICENSE GRANTED 03/03/89  
TITLE  
DESIGNING IMPROVED HUMANIZED IMMUNOGLOBULINS

\* SMALL ENTITY \*

PRELIMINARY CLASS: 435

(see reverse)

RECEIVED  
TOWNSEND & TOWNSEND  
MAR -9 APR 11 1989

## EXHIBIT A

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark OfficeAddress: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/290,975	12/28/88	QUEEN	C 118236

RECEIVED

WILLIAM M. SMITH  
 TOWNSEND AND TOWNSEND  
 STEUART STREET TOWER, ONE MARKET PLAZA  
 SAN FRANCISCO, CA 94105

EXAMINER	
MARKS, R	
ART UNIT	PAPER NUMBER
185	2

*Response Due December 7, 1989 DPA*

11/07/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined       Responsive to communication filed on \_\_\_\_\_       This action is made final.

A shortened statutory period for response to this action is set to expire 0 month(s), 30 days from the date of this letter.  
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

## Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.       | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449             | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____   |

## Part II SUMMARY OF ACTION

1.  Claims 1-26 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims \_\_\_\_\_ are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims 1-26 are subject to restriction or election requirement.

7.  This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8.  Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are  acceptable;  not acceptable (see explanation).

10.  The  proposed drawing correction and/or the  proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved.  disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other





118251  
W.M.

**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address : COMMISSIONER OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/310,252	02/13/89	QUEEN	C 118239
		1990 JUN -4 AM 10:38	

RECEIVED

WILLIAM M. SMITH  
 TOWNSEND AND TOWNSEND  
 STEUART STREET TOWER  
 ONE MARKET PLAZA  
 SAN FRANCISCO, CA 94105

EXAMINER	
MARKUS M. ART UNIT	PAPER NUMBER
3	
DATE MAILED:	

06/01/90

**NOTICE OF ABANDONMENT**

This application is abandoned in view of:

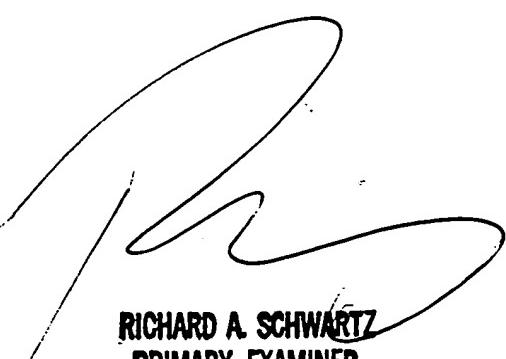
1.  Applicant's failure to respond to the Office letter, mailed 07 November 1989.
2.  Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
3.  Applicant's failure to timely file the response received \_\_\_\_\_ within the period set in the Office letter.
4.  Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of \_\_\_\_\_ of the Notice of Allowance.

- The issue fee was received on \_\_\_\_\_ .  
 The issue fee has not been received in Allowed Files Branch as of \_\_\_\_\_ .

In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17 (l), and a verified showing as to the causes of the delay.

If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of Delgar Inc. v. Schuyler, 172 U.S.P.Q. 513.

5.  Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by \_\_\_\_\_ as required in the last Office action.  
 The corrected and/or substitute drawings were received on \_\_\_\_\_ .
6.  The reason(s) below.

  
 RICHARD A. SCHWARTZ  
 PRIMARY EXAMINER  
 ART UNIT 121/65

CANADIAN- N Y OR N

## PATENT APPLICATION

FILE# 009

CIP APP: DESIGNING IMPROVED

ENTRY DATE 21589

80

APPLICANT PROTEIN DESIGN LABS, INC.  
CLIENT# ATTN: CONTROLLER  
11823 2375 GARCIA AVENUEMAIL DATE 21389 TYPE (L/D/P) L DISCL SENT( Y/N )  
INVNTRS QUEEN, CARY SELICK, HAROLD  
FILING DATE 21389 SERIAL# 310252 GROUP 185 FIRST PUBLIC USE  
REEL: 5042 FRAME: 376 REC'D DATE 21389 ASSIGNEE PROTEIN DESIGN LABS  
TITLE OF INVENTION: DESIGNING IMPROVED HUMANIZED IMMUNOGLOBULINSP.O. ACTION RESPONSE DUE EXT  
AMENDMENT DATED STATUS DATE C=COMPLETE  
P.O. ACTION RESPONSE DUE EXT  
AMENDMENT DATED STATUS DATE C=COMPLETE  
P.O. ACTION RESPONSE DUE EXTNOTICE OF APPEAL DUE NOTICE OF APPEAL EXT SENT  
APPEAL BRIEF DUE INFORMAL STATUS \*N\*=NO MAINT. FEE N=NO FOR FILE  
ALLOWED DRAWINGS DUE  
ISSUED ISSUE FEE DUE  
PATENT# DELIVERED PAID REMOVE  
DISB DATE CODE AMT DESCPARTS DUE CK1 FOR DIFF # CODE CK5 = OTHER ACTIONS  
CK7 TO RESTART W/O CHANGE  
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11823-8

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
CARY L. QUEEN ET AL. ) Examiner: M. Marks  
Serial No.: 07/290,975 ) Art Unit: 185  
Filed: December 28, 1988 ) RESPONSE TO RESTRICTION  
For: NOVEL IL-2 RECEPTOR- ) REQUIREMENT  
SPECIFIC HUMAN IMMUNO- )  
GLOBULINS ) San Francisco, CA 94105

Commissioner of Patents and Trademarks  
Washington, D. C. 20231

Sir:

REMARKS

In response to the requirement for election and restriction, which is the only point raised in the Official Action, Applicants hereby provisionally elect Group I consisting of Claims 1-20 and 22-24, but traverse the requirement as to the other Groups. It is believed that all of the claims are so closely related to those designated in Group I that they should remain in the same application to preserve unity of invention. Contrary to the Examiner's statements, all relate generally to compositions comprising human-like immunoglobulins reactive with the human interleukin-2 receptor, and their use and production. Thus, all should be examined in a single application, accordingly.

The Examiner's statements regarding the relationship between the IL-2 receptor and "p55 Tac" and how "non-recombinant immunoglobulins specific for Tac" can be used are not understood. Clarification is requested.

With respect to the claims constituting Groups II and III, Applicants reserve the right to file a divisional application for the claimed subject matter. Applicants do not waive any of their rights or abandon any subject matter in the

non-elected claims. Since Applicants have fully and completely responded to the Official Action and have made the required election, this application is now in order for early action.

Respectfully submitted,  
TOWNSEND and TOWNSEND

By W.M.S.  
William M. Smith  
Reg. No. 30,223

Date: 03-07-90

Telephone: (415) 326-2400

One Market Plaza  
Steuart Street Tower  
San Francisco, CA. 94105

I HEREBY CERTIFY THAT THIS COMMERCIAL MESSAGE IS BEING DEPOSITED  
WITH THE UNITED STATES POSTAL SERVICE / FIRST CLASS MAIL IN  
AN ENVELOPE TO THE COMMISSIONER OF PATENTS AND  
TRADEMARKS, WASHINGTON, D.C. 20591 ON 7/12/1990  
(DATE OF DEPOSIT)

TOWNSEND AND TOWNSEND  
DATE 7/12/1990 BY J.L.K.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
 CARY L. QUEEN ET AL. ) Examiner: M. Marks  
 Serial No.: 07/290,975 ) Art Unit: 185  
 Filed: December 28, 1988 ) PETITION TO EXTEND TIME  
For: NOVEL IL-2 RECEPTOR- ) UNDER 37 CFR §1.136(a)  
SPECIFIC HUMAN IMMUNO-  
GLOBULINS ) San Francisco, CA 94105

Commissioner of Patents and Trademarks  
 Washington, D. C. 20231

Sir:

Applicants petition the Commissioner of Patent and Trademarks to extend the time for response to the Office action dated November 7, 1989 for three months, from December 7, 1989 to March 7, 1990. An appropriate response to the Office Action in the form of a Response to Restriction Requirement is enclosed herewith.

Please charge \$215.00 to the Deposit Account No. 20-1430. Please charge any additional fees or credit overpayment to the above Deposit Account. This Petition is submitted in triplicate.

Respectfully submitted,

TOWNSEND and TOWNSEND

By W.M. Smith  
 William M. Smith  
 Reg. No. 30,223

Date: 03-07-80

Telephone: (415) 326-2400

One Market Plaza  
 Steuart Street Tower  
 San Francisco, CA. 94105

I HEREBY CERTIFY THAT THIS COMMERCIAL MAIL IS ENCLOSED  
 WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN  
 AN ENVELOPE ADDRESSED TO: COMMISSIONER OF PATENTS AND  
 TRADEMARKS, WASHINGTON, D.C. 20231, ON 7 Mar 1990  
 (DATE OF DEPOSIT)

TOWNSEND AND TOWNSEND  
 DATE 7 Mar 1990 BY J. K. K.

## TO THE U.S. PATENT OFFICE

Please stamp the date of receipt of  
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Title of Document ..... RESPONSE TO RESTRICTION REQUIREMENTS, PETITION TO EXTEND TIME  
 Date Due..... March 7, 1990.....  
 Serial No. .... 07/290,975.....  
 Date Mailed ..... March 7, 1990.....  
 File No. .... 11823-8.....  
 Attorney ..... WMS.....

11823-9

## TO THE U.S. ATENT OFFICE

Please stamp the date of receipt of  
the following document, and return this  
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Title of Document ..... RESPONSE TO RESTRICTION REQUIREMENTS, PETITION TO EXTEND TIME  
 Date Due..... March 7, 1990.....  
 Serial No. .... 07/290,975.....  
 Date Mailed ..... March 7, 1990.....  
 File No. .... 11823-8.....  
 Attorney ..... WMS.....



JULY 22 PM 3:15

11823-9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
CARY L. QUEEN ET AL. ) Examiner: M. Marks  
Serial No.: 07/310,252 ) Art Unit: 185  
Filed: February 13, 1989 ) VERIFIED STATEMENT OF  
For: DESIGNING IMPROVED ) DEBRA B. HUDSON  
HUMANIZED IMMUNOGLOBULINS )  
\_\_\_\_\_  
San Francisco, CA 94105

Commissioner of Patents and Trademarks  
Washington, D. C. 20231

Sir:

I, Debra B. Hudson, declare and state as follows:

1. I am a docket clerk with the docket department (U.S.) at Townsend and Townsend, San Francisco, California. I have been a docket clerk at Townsend and Townsend since 1986.
2. I am responsible for handling incoming mail from the U.S. Patent and Trademark Office.
3. The following procedures and controls are utilized by the docket department with respect to correspondence received from the PTO:
  - i. When communications from the PTO are received in the mailroom, they are immediately date-stamped, and are then sent to the appropriate docketing department (U.S. or foreign). Mail is delivered from the mailroom directly to the docketing department, first thing each morning.
  - ii. On receiving the PTO communication in the docketing department, the docket clerk will enter the serial number of the application into the computer, to call up the appropriate docket file.
  - iii. The docket clerk will then put the working attorney's initials and the firm file number in red on the upper right hand corner of the document.

iv. The docket clerk will also place a red stamp reading "Response Due" on the front of the office action, and write in large red letters the date the response is due.

v. The docket clerk will then enter the PTO action and date, and the response due date into the computer docket sheet.

vi. The PTO communication is then immediately forwarded to the working attorney.

vii. Entries are also made in the computer docket when communications are sent from the working attorney to the PTO.

4. I was the docket clerk who handled the office action, mailed November 7, 1989, in Application Serial No. 07/290,975. The standard procedures and controls were followed in the situation at hand:

i. The docketing department received an office action in the case of Application Serial No. 07/290,975, which had been mailed on November 7, 1989, and had been date-stamped in the mailroom as received on November 10, 1989.

ii. I received that document, stamped and wrote the "Response Due" date (December 7, 1989) on the front of the document in red ink, wrote the working attorney's initial and the firm file number (WMS 11823-8) in the top right hand corner of the front page, and entered the relevant information into the computer docket. I signed my initials on the front page after the Response Due date (DBH).

iii. No office action was entered into the computer docket on that date, or any other date, for the case of Application Serial No. 07/310,252.

I further declare that all statements made herein of my own knowledge are true and that all statements made on

information and belief are believed to be true; and further that I make these statements with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: 6-19-90

  
Debra B. Hudson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
CARY L. QUEEN ET AL. ) Examiner: M. Marks  
Serial No.: 07/310,252 ) Art Unit: 185  
Filed: February 13, 1989 ) VERIFIED STATEMENT OF  
For: DESIGNING IMPROVED ) MICHELE A. SIMONE  
HUMANIZED IMMUNOGLOBULINS )  
\_\_\_\_\_) San Francisco, CA 94105

Commissioner of Patents and Trademarks  
Washington, D. C. 20231

Sir:

I, Michele A. Simone, declare and state as follows:

1. I am a docket clerk with the docket department (U.S.) at Townsend and Townsend, San Francisco, California.
2. I am responsible for handling incoming mail from the U.S. Patent and Trademark Office.
3. The docketing department received and entered into the computer docket a Notice of Abandonment for Application Serial No. 07/310,252, for failure to respond to an office action allegedly mailed November 7, 1989. The document was date-stamped as received on June 4, 1990. I received the document, and wrote the firm file number and working attorney's initials in red in the top right hand corner of the document.
4. I immediately checked to see if there was any record of receipt of the November 7, 1989 office action. There was none.
5. I forwarded the Notice of Abandonment to the working attorney. I did not "abandon" the case; that is, I did not enter the Notice of Abandonment on the docket sheet, awaiting instructions from the working attorney as to whether the case was or was not to be abandoned.

I further declare that all statements made herein of my

09-11-000006

own knowledge are true and that all statements made on information and belief are believed to be true; and further that I make these statements with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: 6-19-90

Michele A. Simone  
Michele A. Simone

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DEXTER B. LOUIE  
A. JAMES ISBESTER

CHARLES E. TOWNSEND, JR.  
JOHN L. MCGANNON  
OF COUNSEL

\*NOT ADMITTED IN CALIFORNIA

PATENTS, TRADEMARKS, AND COPYRIGHTS

379 LYTTON AVENUE  
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(415) 326-2400  
FAX (415) 326-2422

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STEUART STREET TOWER  
ONE MARKET PLAZA  
SAN FRANCISCO, CALIFORNIA 94105  
(415) 543-9600  
SAN FRANCISCO FAX (415) 543-5043

SEATTLE OFFICE  
1201 THIRD AVENUE  
SUITE 2600  
SEATTLE, WASHINGTON 98101  
(206) 467-9600  
SEATTLE FAX (206) 623-6793

CHARLES E. TOWNSEND (1904-1944)  
STEPHEN S. TOWNSEND (1942-1986)

WRITER'S DIRECT DIAL NUMBER:

October 24, 1990

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Attn: Ms. Ellen Scott - Group 180

Re: U.S. Serial No. 07/310,252  
Our File: 11823-9

Dear Ms. Scott:

Pursuant to your request of October 23, 1990, attached is a complete copy of our file wrapper and cited references for the above identified patent application. It is our understanding that the Patent Office Official Search has not located this file.

We appreciate your immediate processing of this file within the Group so that we may obtain a decision responsive to our Petition for Withdrawal of Holding of Abandonment filed June 20, 1990.

Yours very truly,

TOWNSEND and TOWNSEND

  
William M. Smith

WMS/1  
Encl. (as noted)  
\wp50\11823\009.L02

TO THE U.S. PATENT OFFICE

Please stamp the date of receipt of  
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Title of Document ..... PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT  
six exhibits, two verified statements

Date Due.....

Serial No. ....07/310,252.....

Date Mailed ....June 20, 1990.....

File No. ....11823-9.....

Attorney ..... WMS .....

TO THE U.S. PATENT OFFICE

Please stamp the date of receipt of  
the following document, and return this  
card to us.

RECEIVED

File- 11823-9

Title of Document ..... PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT  
six exhibits, two verified statements

Date Due.....

Serial No. ....07/310,252.....

Date Mailed ....June 20, 1990.....

File No. ....11823-9.....

Attorney ..... WMS .....

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
CARY L. QUEEN ET AL. ) Examiner: M. Marks  
Serial No.: 07/310,252 ) Art Unit: 185  
Filed: February 13, 1989 ) VERIFIED STATEMENT OF  
For: DESIGNING IMPROVED ) DEBRA B. HUDSON  
HUMANIZED IMMUNOGLOBULINS )  
\_\_\_\_\_) San Francisco, CA 94105

Commissioner of Patents and Trademarks  
Washington, D. C. 20231

Sir:

I, Debra B. Hudson, declare and state as follows:

1. I am a docket clerk with the docket department (U.S.) at Townsend and Townsend, San Francisco, California. I have been a docket clerk at Townsend and Townsend since 1986.
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Debra B. Hudson

#4  
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iii. No office action was entered into the computer docket on that date, or any other date, for the case of Application Serial No. 07/310,252.

I further declare that all statements made herein of my own knowledge are true and that all statements made on

OCT 1989 2 -

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information and belief are believed to be true; and further that I make these statements with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: 6-19-90

  
Debra B. Hudson

104  
LM  
5/29/92

FEB 11 1990

20 MAY 29 1990 58

11823-9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
CARY L. QUEEN ET AL. ) Examiner: M. Marks  
Serial No.: 07/310,252 ) Art Unit: 185  
Filed: February 13, 1989 )  
For: DESIGNING IMPROVED )  
HUMANIZED IMMUNOGLOBULINS )  
\_\_\_\_\_) San Francisco, CA 94105

Commissioner of Patents and Trademarks  
Washington, D. C. 20231

DECLARATION OF WILLIAM M. SMITH

Sir:

I, William M. Smith, declare and state as follows:

1. I am an attorney of record for application Serial No. 07/310,252 filed February 13, 1989 ("the '252 application"), and also for application Serial No. 07/290,975, filed December 28, 1988 ("the '975 application"). The '252 application is a C-I-P application of the '975 application.
2. I received an Office Action, mailed November 7, 1989, requiring election or restriction in the '975 application.
3. On March 7, 1990, on behalf of Applicants, a timely response to the November 7, 1989 Office Action in the '975 application was filed.
4. I have never received any written Office Action in the '252 application.
5. Beginning on or about May 17, 1990, Examiner Marks and I had telephone conferences in which the Examiner, inter alia,

pages 2 thru 4 missing

confirmed receipt of the response in the '975 case and inquired about a response in the '252 case. This was the first notification I had received that there had been an official written action in the '252 case, and that a restriction or election was required. In that telephone conversation, Examiner Marks explained which claims were included in each of the three groups for restriction.

6. Upon learning of the restriction requirement, a response was diligently prepared on behalf of Applicants, which response is being mailed concurrently with this Declaration.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that I make these statements with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize validity of the application or any patent issuing thereon.

Respectfully submitted,

Date: 5-26-80

By: W.M.S.  
William M. Smith  
Reg. No. 30,223

\wp50\PDL\009.P01

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11823-9

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
CARY L. QUEEN ET AL. ) Examiner: M. Marks  
Serial No.: 07/310,252 ) Art Unit: 185  
Filed: February 13, 1989 ) VERIFIED STATEMENT OF  
For: DESIGNING IMPROVED ) MICHELE A. SIMONE  
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Respectfully submitted,

Date: 6-19-90

Michele A. Simone  
Michele A. Simone

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of )  
 CARY L. QUEEN ET AL. ) Examiner: M. Marks  
 Serial No.: 07/310,252 ) Art Unit: 185  
 Filed: February 13, 1989 ) POWER TO INSPECT  
 For: DESIGNING IMPROVED )  
 HUMANIZED IMMUNOGLOBULINS )  
 \_\_\_\_\_) San Francisco, CA 94105

Commissioner of Patents and Trademarks  
 Washington, D. C. 20231

Sir:

This is to authorize Tommy L. Foster or Terri Ruggiero or David Yohannan of the firm of PRIOR ART SEARCHES, INC. whose address is Suite 304, 2001 Jefferson Davis Highway, Arlington, Virginia 22202-3603 to inspect the file of the above-identified patent application and to make copies of all or any part of the application and assignment records.

Respectfully submitted,

TOWNSEND and TOWNSEND

By William M. Smith  
 William M. Smith  
 Reg. No. 30,223

Date: 06-21-90

Telephone: (415) 326-2400

One Market Plaza  
 Steuart Street Tower  
 San Francisco, CA. 94105

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